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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/976,294	11/21/97	WESTERLAGE	019743.0261

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LM01/0126

EXAMINER  
COSIMANO, E

ART UNIT  
2761

PAPER NUMBER

DATE MAILED: 01/26/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/976,294**

Applicant(s)  
**Westerlage et al**

Examiner  
**Edward R. Cosimano**

Group Art Unit  
**2761**



☒ Responsive to communication(s) filed on Nov 27, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 38-79 is/are pending in the application.

Of the above, claim(s) none is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 38-79 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Nov 21, 1997 is/are objected to by the Examiner.

☒ The proposed drawing correction, filed on Nov 27, 1998 is ☒ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. Applicant should note the changes to patent practice and procedure effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997.

2. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, & § 1.84(o,p(5)).

3. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

3.1 Claims 38-79 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Haendel (5,359,528) in view of Gooch (5,396,540).

3.1.1 In regard to the claims, Haendel ('528) discloses the determining of the location of a monitored vehicle using a GPS position determining system and the vehicle's odometer. This data as well as the applicable tax for the vehicle's location based on a gridwork of cells that define a region is recorded. The recorded data indicates an apportionment of the applied taxes to a particular authority. The recorded data is then used to generate a report of the vehicle's log. However, this data is not transmitted to a remote central location as claimed.

3.1.1.1 In regard to the claims, Gooch ('540) discloses a central authority which determines the cost of something based on the position of the originating object. To determine the position of the object, Gooch ('540) uses a GPS or LORAN-C position determining system to determine the location of a monitored vehicle. When the cost of something needs to be determined, i.e. a configurable condition, the position data is transmitted to a remote central location, i.e. central

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authority. The central authority then uses the position data to plot the vehicle's location with respect to a gridwork of cells that define a region so that the appropriate cost may be correctly determined. It is noted that each of the cells in the grid of Gooch ('540) may have a different cost value assigned to the cell.

3.1.1.2 Since the taxing authority for hire vehicles, i.e. taxies, shippers etc., as taught by Haendel ('528) would operate from a central location and would need to collect the data necessary to calculate the correct tax, it would have been obvious to one of ordinary skill at the time the invention was made that the system of Haendel ('528) could be modified to:

A) transmit the vehicle data to a central location as taught by Gooch ('540) using any suitable communications link absent applicant's showing of new and unexpected results from using a particular communications link.

B) use a GPS system to determine the vehicle's location.

3.1.1.3 As per the automatic determination of distance and the tax, since each of these features are taught by Haendel ('528), it would have been obvious to one of ordinary skill at the time the invention was made that these functions are performed automatically by the computer of Haendel ('528) to prevent the possibility of human error.

3.1.1.3.1 It is further noted that even if it could be shown that these functions are not performed automatically in Haendel ('528) then it would have been obvious to one of ordinary skill at the time the invention was made that the determination of distance and applicable taxes could be automated in the computer of Haendel ('528) to prevent the possibility of human error. Also, as the Court has stated it is not invention to broadly replace manual activity with an automatic activity that accomplishes the same result, (*In re Venner and Bowser*, 120 U.S.P.Q. 192 @ 194 (CCPA, 1958)).

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

4.1 A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL

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AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

5. Response to applicant's arguments.

5.1 All rejections and objections of the previous Office action not repeated or modified and repeated here in have been over come by applicant's last response.

5.2 As per the 35 U.S.C. § 103 rejection, since:

A) since Gooch (5,396,540) determines the cost of something based in part on position data just as in the instant application, applicant's arguments that Gooch (5,396,540) is non analogous art are non persuasive.

B) since the reject as set forth above is Haendel (5,359,528) in view of Gooch (5,396,540), applicant's arguments that either Haendel (5,359,528) or Gooch (5,396,540) do not teach something taught by the other reference are non persuasive.

C) since both Haendel (5,359,528) and Gooch (5,396,540) are implemented in the environment of computers, applicant's arguments that either Haendel (5,359,528) or Gooch (5,396,540) do not teach something which commonly occurs in this environment, i.e. storing data in memory, are non persuasive.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Voeltz, can be reached on (703)-305-9714. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

6.1 The fax phone number for UNOFFICIAL FAXES for this group is (703) 308-<sup>9</sup>5387.

6.2 The fax phone number for OFFICIAL FAXES for this group is either (703) 308-9051 or (703) 308-9052.

01/17/99



Edward R. Cosimano

Primary Examiner A.U. 2761